

09/836,976

00RE098

REMARKS

Claims 1-27 in the subject application are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-8, 11-18, and 21-27 Under 35 U.S.C. §103(a)

Claims 1-8, 11-18, and 21-27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Marshall *et al.* (U.S. Patent No. 5,685,398) in view of McCarthy (U.S. Patent No. 4,181,201). It is submitted that this rejection be withdrawn for at least the following reasons. The combination of Marshall *et al.* and McCarthy do not teach or suggest all the claim limitations of the subject application.

To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) *must teach or suggest all the claim limitations*. See MPEP §706.02(j). The *teaching or suggestion to make the claimed combination* and the reasonable expectation of success *must both be found in the prior art and not based on applicant's disclosure*. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

In particular, neither Marshall *et al.* nor McCarthy teach or suggest a lever and cam assembly coupled to the armature plate and the field cup, the lever and cam assembly being operable to separate the armature plate from the friction disk. In the Office Action dated September 13, 2002, the Examiner conceded that Marshall *et al.* does not disclose a cam means to actuate the lever device. Accordingly, the Examiner relied on McCarthy to teach this element. However,

09/836,976

00RE098

the structure described in McCarthy does not teach or suggest the structure claimed in the present invention.

The McCarthy structure involves a cam engaging latch arm 88 coupled to a handle 92. To manually release the brake, the handle must be turned 90°, such that the latch arm 88 engages with a U-shaped cam portion 64 and pivots the cam portion 64 and a supporting lever 24 to release a brake shoe 46 from a frictional braking engagement with a brake disc 16. The cam engaging latch arm 88 and handle 92 assembly is a separate structure from the cam portion 64 and the supporting lever 24, as shown in Fig. 1 of McCarthy. Neither, the cam engaging latch arm 88, the cam portion 64, nor the supporting lever 24 is coupled to an armature plate or a field cup. Moreover, the structure taught by McCarthy would be inoperable for separating an armature plate from a friction disk as the cam engaging latch arm 88 and supporting lever 24 assembly would only be able to release one side of the armature plate from engagement with the friction disk. The cam engaging latch arm 88 in combination with the handle 92 and the supporting lever 24 is only operable to release a brake shoe from engagement with a brake disc. Thus, McCarthy fails to disclose, teach or suggest a lever and cam assembly coupled to an armature plate and a field cup, the lever and cam assembly being operable to separate the armature plate from a friction disk, as required by claim 1 of the present invention.

The Examiner argues that it would have been obvious to one of ordinary skill in the art at the time the invention was made to use a cam means as taught by McCarthy in the brake of Marshall *et al.* in order to provide a good mechanical advantage in a compact space. However, the structure of the brake disclosed in Marshall *et al.* does not provide for a cam and lever assembly as there is no apparent surface for a cam portion to make contact.

Further, to establish a case of obviousness, the cited references must provide "a teaching, suggestion, or reason to substitute [an element or limitation] ... in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination." *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573, 1579, 42 U.S.P.Q.2d 1378 (Fed. Cir. 1997). The Federal Circuit has consistently held that in order to establish obviousness vis-a-vis a

09/836,976

99RE098

combination of cited references, the cited references must themselves provide a suggestion for the combination to one of ordinary skill in the art. The suggestion for such a combination cannot and must not be based on applicant's disclosure using hindsight. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Marshall *et al.* is directed to a fast response adjustable brake, which includes a magnetically permeable body, an armature, an energization coil, a pressure plate mounted to the body, and a friction disc between the armature and pressure plate. Marshall *et al.* describes a manual release mechanism which includes pivot-bases with radially inwardly extending tabs for engaging and pushing the armature away from the friction disc. McCarthy, on the other hand, is directed to a brake mechanism wherein a support lever is pivoted at a pivot end to a stationary end plate and is urged by a spring, which engages the support lever at its free end, toward the end plate to effect clamping of a rotatable friction disc between a brake shoe and friction plates disposed near the pivot end of the support lever. It is submitted that one of ordinary skill in the art would not have looked toward a brake system which employs a brake shoe, when modifying a brake release mechanism for a brake system which employs an armature plate.

Further, the courts have condemned merely isolating elements from various references to support an obviousness rejection based on a combination of references.

The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Block Drug*, 786 F.2d at 1143 n. 5., 229 USPQ at 187 n. 4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985).

Furthermore, according to the Federal Circuit,

... 'virtually all [inventions] are combinations of old elements.' Therefore an examiner may often find every element of a claimed invention in the prior art. *If identification of each claimed element in the prior art were sufficient to negate patentability, very few*

09/836,976

99RE098

patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. *Such an approach would be 'an illogical and inappropriate process by which to determine patentability.'* In re Rouffet, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) (citations omitted).

Although Marshall *et al.* teaches the use of a manual brake release mechanism to separate an armature plate with a friction disk, Marshall *et al.* fails to teach or suggest the use of a lever and cam assembly, as discussed above. Furthermore, Marshall *et al.* fails to suggest any desirability or provide any motivation to be combined with the brake shoe release mechanism of McCarthy. Likewise, any suggestion to modify the manual brake release mechanism is absent from Marshall *et al.*

Thus, for at least the aforementioned reasons, the combination of Marshall *et al.* and McCarthy does not make obvious claims 1, 11, 21, and 27. Claims 2-10, 12-20, and 22-26 respectively depend from claims 1, 11, and 21. Accordingly, withdrawal of this rejection and allowance of claims 1-27 are respectfully requested.

II. Objection of Claims 9, 10, 19, and 20

Claims 9, 10, 19, and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As claims 9, 10, 19, and 20, are indirectly dependent upon independent claims 1 and 11, which are now believed to be allowable per the aforementioned reasons, it is believed these claims are now also allowable.

09/836,976

99RE098

CONCLUSION

The present application is believed to be condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

In the event any additional fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to Deposit Account No. 01-0857.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin
Reg. No. 40,894

24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone (216) 696-8730
Facsimile (216) 696-8731

Official

FAX RECEIVED

DEC 10 2002

GROUP 3600